

REMARKS

The Examiner rejected claims 160-162, while withdrawing claims 143-159 from consideration. Claims 143-159 have been cancelled without prejudice. In addition, claims 163-174 have been added. Thus, claims 160-174 are pending.

Claim 160 has been amended herein to its originally presented form. New claims 163-174 depend from amended claim 160. Applicants' specification fully supports these amendments. See, *e.g.*, originally filed claims 27 and 126-129. Thus, no new matter has been added.

In light of these amendments and the following remarks, Applicants respectfully request continued examination of the above-referenced application and allowance of claims 160-174.

Rejection under 35 U.S.C. § 103

The Examiner rejected claims 160-162 as allegedly being unpatentable over the Nilsen *et al.* reference (U.S. Pat. No. 6,013,447) in view of the Taira *et al.* reference (U.S. Pat. Pub. No. 2004/0002077) and the Hertzl *et al.* reference (*J. Lipid Res.*, 41: 1082-1086 (2000)).

Applicants respectfully disagree and request withdrawal of these rejections. As demonstrated by the attached Declarations under 37 C.F.R. § 1.131, Applicants invented the presently claimed subject matter prior to the filing date of the Taira *et al.* reference. Exhibit A, which comprises redacted copies of three notebook pages, corroborates Applicants' earlier invention. For example, pages 1 and 2 of Exhibit A provide diagrams of Applicants' methods for selection of siRNA molecules from an siRNA random library, while page 3 provides diagrams of Applicants' methods for the construction of a short hairpin RNA (shRNA) library and selection of shRNA molecules using GFP. These notebook pages are comparable to published figures 20, 21, 25, and 26 of Applicants' specification (*see, e.g.*, Exhibit B and pages 21-22 of Applicants' specification).

For these reasons and others, Applicants respectfully request withdrawal of the rejection of claims 160-162 under 35 § U.S.C. 103(a).

CONCLUSION

Applicants submit that claims 160-174 are in condition for allowance, which action is respectfully requested. The Examiner is invited to telephone the undersigned attorney if such would expedite prosecution.

A Petition for One-Month Extension of Time under 37 C.F.R. §1.136 is submitted herewith. The Commissioner is authorized to charge any fees or credit any overpayments to Deposit Account No. 06-1050.

Respectfully submitted,

Date: May 5, 2009

/Lisbeth C. Robinson/

Lisbeth C. Robinson, Ph.D.

Reg. No. 59,704

Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, Minnesota 55402
Telephone: (612) 335-5070
Facsimile: (877) 769-7945

60570212.doc

CERTIFICATE OF MAILING BY EFS-WEB FILING

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date May 5, 2009